



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

cd

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,893	01/24/2002	Thomas J. Lochtefeld	P-10334-US	1766

27948 7590 12/29/2003

LAW OFFICES OF JONATHAN A. BARNEY, ESQ.
312 SIGNAL ROAD
SUITE 200
NEWPORT BEACH, CA 92663

EXAMINER

CHIU, RALEIGH W

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/29/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,893

Applicant(s)

LOCHTEFELD, THOMAS J.

Examiner

Raleigh Chiu

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-19, 41-49, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 41-49, 51 and 52 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lochtefeld in view of Hill and Derrah as applied in the previous office action.

Regarding claims 1, 3 and 19, Lochtefeld discloses the recited surf-riding apparatus except that it is designed for actual surfers and not for use with toy surf-action figures. However, as described in the previous Office action, Hill teaches the concept of extending surf-riding apparatuses for actual surfers to miniature apparatuses using toy-sized models. See bridging paragraph between columns 24-25 of Hill. Therefore, it would have been obvious to one of ordinary skill in the art to use toy surf-action figures in a scaled-down Lochtefeld surf-riding apparatus. Although Hill does not explicitly disclose his toy-sized models being adapted to be radio-controlled, it would have been obvious to one of ordinary skill in the art to control the toy surfing action figures with a radio-controlled transmitter and actuator in view of Derrah who teaches that it is old and well-known in the art to control

Art Unit: 3711

toy surf-action figures in the water for more realistic surfing action.

Applicant argues on page 7 of his Remarks that Hill does not disclose or suggest the desirability of a surf action game including one or more controllable surface action figures.

Likewise, Darrah [sic, Derrah] does not disclose or suggest the desirability of a surf action game, as recited by the applicant's claims, using a radio-controlled surfing toy.

However, the test for obviousness is not whether the features may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Applicant has done no more than to select a plurality of individual features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result.

Regarding claim 2, although Lochtefeld discloses a containerless system, it would have been obvious to one of ordinary skill in the art to provide sidewalls to contain the

Art Unit: 3711

water within the system as taught by Hill. See Hill at column 10, lines 31-36.

Regarding claim 4, collecting basin 12 of Lochtefeld serves as the recited drain.

Regarding claim 5, Figure 4c of Lochtefeld shows nozzle 7 extending substantially across the ride surface width.

Regarding claim 6, the number of nozzles is not considered to be critical.

Regarding claims 7-9, Figure 3a of Lochtefeld further shows a reservoir 16, a source of water 14a and a recirculating pump.

Regarding claims 10 and 13, in view of the Hill teaching of a scaled-down water toy for children, it would have been obvious to one of ordinary skill in the art to use the most commonly-used nozzled apparatus found within the household to operate the toy.

Regarding claims 11 and 12, Figures 4g and 4c of Lochtefeld show a grate 22 and recovery pool 14.

3. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lochtefeld and Hill and Derrah in view of Huber.

Regarding claims 10 and 13, in the alternative, it would have been obvious to one of ordinary skill in the art to provide water through a hose in view of Huber who shows in Figure 1 that

Art Unit: 3711

it is old and well-known in the art to use such an expedient to provide continuous water under pressure in a child's water toy.

Allowable Subject Matter

4. Claims 17, 18, 41-49, 51 and 52 are allowed.

Response to Arguments

5. Applicant's arguments filed 06 October 2003 have been fully considered but they are not persuasive.

No specific arguments have been directed against the rejection of claims 2-15.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

Art Unit: 3711

from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on (703) 308-1513.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif
23 December 2003